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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/054,602	04/03/1998	DENNIS EDWARD SMITH	74311ACFR	2765

1333 7590 11/21/2002

PATENT LEGAL STAFF  
EASTMAN KODAK COMPANY  
343 STATE STREET  
ROCHESTER, NY 14650-2201

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 11/21/2002

22

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant No.

09/054,602

Applicant(s)

SMITH ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 August 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 11-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11-23 and 25 is/are rejected.
- 7) ☒ Claim(s) 1, 3, 5, 12, 18 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Response to Arguments**

1. ***After further consideration and an exhaustive deliberation coupled with appellant's persuasive arguments, the rejections based on McNeil, Utsumi et al and Kamiyama et al are herein withdrawn, with the understanding that the proposed amendment to claims 1, 3, 12, 18 and 21 per paper no. 16, 01/29/02, denied entry, is repeated in response to this Office Action along with use of the singular form of "salt". However, in view of the newly discovered, substantive 112, 2<sup>nd</sup> paragraph issue(s), PROSECUTION IS HEREBY REOPENED. The substantive 112, 2<sup>nd</sup> paragraph issue(s) and previously raised claim Objections are set forth below.***

**Claim Objections**

2. ***Claims 1, 3, 5, 12, 18 and 21 are objected to because of the following informalities: a) In claim 1 @ line 12, "by weight" should be inserted after "20%" so as to engender claim language clarity; b) In claim 3 @ lines 2 and 3, "an acrylic acid and a methacrylic acid" should read "acrylic acid and methacrylic acid" so as to engender claim language clarity; c) In claim 5, @ line 3, "by weight" should be inserted after "50%" so as to engender claim language clarity; d) In claim 12 @ line 1, claim 18 @ line 1 and claim 21 @ line 1, "6", "18" and "20", respectively, should be deleted and "11", "17" and "20", respectively, should be inserted in their stead so as to engender proper claim dependency; Appropriate correction is required.***

**Claim Rejections - 35 USC § 112**

3. ***The following is a quotation of the second paragraph of 35 U.S.C. 112:***

***The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.***

4. ***Claims 1-5, 11-23 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.***

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A) The recited "monomer B is a water-insoluble ethylenically unsaturated monomer" per at least claim 1 constitutes indefinite subject matter as per the metes and bounds of such engender an indeterminacy in scope, especially since the monomers recited in dependent claims 13, 22 and 25 and definitives of "monomer B" include "water-soluble" monomers.

B) The recited "styrenecarboxylic acid" per claim 2 constitutes indefinite subject matter as per it not being readily ascertainable as to the exact meaning of said compound(s), i.e., does applicant intend a mixture of styrene/carboxylic acid or "styrene monomer" and "carboxylic acid monomer", in the alternative.

C) The recited "wherein monomer B is--" per claims 13, 22 and 25 constitutes indefinite subject matter as per some of the recited monomer species such as acrylonitrile, methacrylonitrile, acrylamide, methacrylamide, vinyl chloride, hydroxyethyl acrylate, etc. do not further limit the antecedently recited "water-insoluble ethylenically unsaturated monomer" per claim 1.

D) The recited "—selected from insoluble metal salts, insoluble metal oxides, oxides,---and resinous polymers—" per claim 22 constitutes indefinite subject matter as per a) the use of improper Markush language, "selected from the group consisting of" is suggested. B) it is not apparent how "oxides" differentiates over "insoluble metal oxides" and c) the metes and bounds of "resinous polymers" engenders and indeterminacy in scope.

#### **Allowable Subject Matter**

5. Claims 1-5, 11-23 and 25 are deemed allowable over the prior art of record, McNeil, Utsumi et al and Kamiyama et al, meritorious of the closest prior art, as per said art neither anticipates nor renders obvious the meticulously defined combination of water-soluble/water-insoluble monomers characterized as having a high carboxylic acid content coupled with a specifically particled sized water-insoluble stabilizer and with a specific amount of water-soluble inorganic salt-governed process, as claimed. One having ordinary skill in the art would not have been endowed with any motivation to extrapolate the specifically claimed combination from any of the prior art, alone or in combination, with any reasonable expectation of success.

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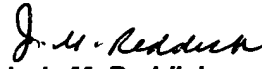
**Conclusion**

6. **Note the attached FORM PTOL 892 for additional prior art cited as of being illustrative of the general state of the art.**

**Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..**

**If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.**

**Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.**

  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR   
November 15, 2002